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For the Northern District of California

IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

FRISKIT, INC.,

No. C 03-5085 WWS (MEJ)

Plaintiff,

**ORDER REGARDING JOINT DISCOVERY
DISPUTE LETTERS DATED FEBRUARY 10,
2006.**

vs.

REALNETWORKS, INC., and
LISTEN.COM.,

Defendants.

Before the Court is parties' joint discovery dispute letters dated February 10, 2006. Specifically, the parties' disputes centers around this Court's December 2, 2005 Order, in which the Court made explicit directives as to Friskit's patent prosecution documents, Friskit's privilege log, and Friskit's production of pre-2000 documents. The Court shall address each issue below.

I. FRISKIT'S PATENT PROSECUTION DOCUMENTS

A. Friskit's failure to Comply with the Court's December 2, 2005 Order

This particular dispute dates back to August of 2005. Friskit was ordered to produce several patent prosecution materials. Previously, Friskit represented that all materials had been produced while Real contested that fact. On September 16, 2005, Friskit was ORDERED to "provide an explanation as to why certain prosecution documents were not produced." The Court, however, did not receive any explanation as to why those particular documents had not been produced or a certification stating that all the documents had been produced prior to the Joint Letter brief submitted on November 8, 2005.

United States District Court
For the Northern District of California

1 The Court afforded Friskit another opportunity to produce the patent prosecution documents
2 and certify under penalty of perjury that all documents had been produced. On December 2, 2005,
3 the Court ORDERED the following:

4 1.) Plaintiff is to certify under penalty of perjury that all documents related to patent
5 prosecution have been produced by December 15, 2005.
6 2.) If any documents have been withheld, Plaintiff is to provide a privilege log by
7 December 15, 2005.
8 3.) The privilege log must comply with the F.R.C.P.
9 **4.) If the Court does not receive the certification by December 15, 2005, at 5:00
p.m., this Court will impose a sanction of \$500.**

10 On February 10, 2006, the parties' submitted a joint letter brief squabbling over whether
11 Friskit had complied with the Court's orders and produced all the patent prosecution documents.
12 Real conceded that Friskit produced patent prosecution materials and provided a certification by
13 December 15. (Joint Letter Brief, page 2.) However, Real claims that the production was deficient
14 and the privilege log entries for the prosecution documents do not comply with F.R.C.P.

15 Friskit claims to have complied with the Court's orders and "timely provided the certification,
16 and placed all privileged documents on its privilege log." Friskit produced over 4000 documents
17 pertaining to the prosecution documents.

18 As an initial matter, Friskit violated the December 2, 2005 Order. The Court never received
19 the certification attesting that all patent prosecution materials have been produced or withheld due to
20 a privilege. This Court specifically stated that a sanction "*will*" be imposed for failure to submit a
21 certification to the Court. Neither the certification nor the privilege log were produced to the Court
22 by December 15, 2005. .

23 Accordingly, the Court hereby ORDERS the following:

24 1.) Real's request for further production of patent prosecution materials is hereby DENIED.
25 2.) Friskit is sanctioned in the amount of \$500 for failing to certify that all prosecution
26 documents had been produced in accordance with the December 2, 2005 Order.
27 3.) Friskit has until Friday, March 9, 2006, at 5:00 p.m. to submit payment to the Clerk of
Court.
28 4.) Friskit has also must submit certification and the privilege log to the Court as soon as

1 possible but no later than Friday, March 9, 2006.

2 5.) Failure to submit any one or all of the above provisions as outlined in 2-4 shall result in a
3 further sanctions.

4 *B. Adequacy of Friskit's privilege log*

5 The parties now dispute the adequacy of Friskit's entries in the patent prosecution privilege
6 log. Real contends that there are entries that do not comport with the F.R.C.P. Real provides the
7 following example:

8 Plaintiff's log contains several entries claiming attorney-client privilege with the author as the
9 law firm "Wilson Sonsini" and the recipient as "File." The description only states
10 "Memorandum to file regarding patent prosecution matters." There is no indication that this
memorandum contains any attorney-client communication at all.

11 Federal Rule 26(b)(5) provides the appropriate standard when a party withholds information
12 based on a claim of privilege:

13 the party shall make the claim expressly and shall describe the nature of the documents,
14 communications, or things not produced or disclosed in a manner that, without revealing
15 information itself privileged or protected, will enable other parties to assess the applicability
16 of the privilege or protection. Fed.R.Civ.P. 26(b)(5).

17 According to the Committee Notes in 1993, "the party must also provide sufficient
information to enable other parties to evaluate the applicability of the claimed privilege or
protection.... [t]he rule does not attempt to define for each case what information must be provided
.... [d]etails concerning time, persons, general subject matter, etc. may be appropriate." Fed. R. Civ.
P. 26(b)(5) Advisory Committee Notes (1993).

18 To facilitate determination of privilege claims, courts may require "an adequately detailed
privilege log in conjunction with evidentiary submissions to fill in any factual gaps." *In Grand Jury
Investigation* 974 F.2d 1068,1071 (9th Cir. 1992).

19 Based upon the Fed. R. Civ. P., Advisory Notes, case law, the parties arguments, and the lack
of evidence submitted to the Court, the Court hereby ORDERS the following:

20 1.) As to Friskit's one example, the Court finds the entry adequate.

21 2.) Friskit is submit to the Court the privilege log by March 9, 2006 at 5:00 p.m. The Court
22 will then review the specific entries 836-839, 841, 843, 848, 858 only.

1 3.) The privilege log should comport with the F.R.C.P. Furthermore, any entry where the
2 recipient or receiver is not an attorney, Friskit is to provide details as to how the privilege applies.

3 4.) Any violation of the terms and provisions provided for in 1-3 shall result in a further
4 sanctions.

5 **II. FRISKIT'S PREVIOUSLY AMENDED PRIVILEGE LOG**

6 On November 8, 2005, Real claimed the privilege log Friskit submitted was inadequate. On
7 December 2, 2005, this Court issued the following order:

8 1.) Defendants' request to waive privilege is hereby DENIED.

9 **2.) Plaintiffs are to explain why several documents for which an attorney client
10 privilege is being claimed where neither the author nor recipient is an attorney is
covered by the privilege.**

11 **3.) Plaintiffs are to explain why the documents cited by Defendants are claimed to be
protected by work product.**

12 **4.) Plaintiffs are to explain why the documents cited by Defendants fall under the
umbrella of "created in anticipation of litigation."**

13 **5.) These explanation are to be submitted to the Court by December 15, 2005, at 5:00
14 p.m.**

15 **6.) If the Court does not receive the explanations by December 15, 2005, at 5:00 p.m.,
16 this Court will impose a sanction of \$500.**

17 It is undisputed that Friskit provided explanations. It is also undisputed that these
18 explanations were not submitted to the Court. Therefore, the Court imposes a \$500 sanction for
19 Friskit's failure to submit the certification to the Court.

20 Next, Real contends that the explanations are inadequate because it does not "identify the
21 actual communication for which privilege is claimed, including the identity of those involved in the
22 communications, the date of the communications, and the subject matter of the communications." In
contrast, Friskit claims that the privilege log comports with the F.R.C.P.

23 As previously stated, "[t]he rule does not attempt to define for each case what information
24 must be provided." Fed. R. Civ. P. 26(b)(5) Advisory Committee Notes (1993). The privilege log
25 "shall describe the nature of the documents, communications, or things not produced or disclosed in
26 a manner that, without revealing information itself privileged or protected, will enable other parties
27 to assess the applicability of the privilege or protection. Fed.R.Civ.P. 26(b)(5). The party must also

1 provide sufficient information to enable other parties to evaluate the applicability of the claimed
2 privilege or protection."Fed. R. Civ. P. 26(b)(5) Advisory Committee Notes (1993).

3 Real listed Entry #56 as being defective. Real provided a copy of this one entry. The Court
4 finds that this one Entry is sufficient under the rules. However, the Court is unwilling to make a
ruling as to the other entries as both parties failed to submit the privilege log to the Court.
5 Accordingly, Friskit is hereby ORDERED to produce the privilege log to the Court by March 9,
6 2006, at 5:00 p.m. The Court will only review the entries Real listed as defective in the February 10,
7 2006, joint letter brief. Failure to comply with the Court's order shall result in further sanctions.

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9 III. PRODUCTION OF PRE-2000 DOCUMENTS

10 On October 6, 2005, this Court ordered Plaintiff to produce pre-2000 documents and to
11 "certify that a document search was performed, and all relevant documents produced, accordingly."
The Court never received such certification.

12 The Court afforded Friskit another opportunity to certify that a document search had been
13 performed and all documents had been produced. On December 2, 2005, the Court ordered the
14 following:

15 1.) Plaintiff is to certify under penalty of perjury that a search for the documents has been
16 completed or produced to the defendant.
17 2.) **The certification should be submitted to the Court by December 15, 2005, at 5:00
p.m.**
18 3.) **If the Court does not receive the certification by December 15, 2005, at 5:00 p.m.,
this Court will impose a sanction of \$500.**

20 Again, the Court received no such certification. Therefore, Friskit is hereby sanctioned \$500
21 for failing to submit the certification to the Court.

22 Next, Real contends that the certification it received from Friskit is defective because the
23 certification does not demonstrate a reasonable search for these documents has been made. The
24 Court disagrees and Real's request is hereby DENIED.

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IV. CONCLUSION

The Court ORDERS the following:

1.) Friskit is sanctioned in the amount of \$500 for each violation of the December 2, 2005 Order, as fully explained above. Accordingly, Friskit IS ORDERED to submit \$1500 to the Clerk of Court by Friday, March 9, 2006, at 5:00 p.m. Failure to do so will result in a further sanctions.

2.) THE COURT ORDERS Friskit to submit certification of the patent prosecution materials and the privilege log pertaining thereto as soon as possible but no later than Friday, March 9, 2006, at 5:00 p.m. Failure to comply with the Court's order shall result in further sanctions.

3.) THE COURT FURTHER ORDERS Friskit to produce the *previously amended* privilege log to the Court by March 9, 2006, at 5:00 p.m. The Court will only review the entries Real listed as defective in the February 10, 2006, joint letter brief. Failure to comply with the Court's order shall result in further sanctions.

IT IS SO ORDERED.

Dated: March 3, 2006



MARIA-ELENA JAMES
United States Magistrate Judge